

**Appl. No.** : 10/722,313  
**Filed** : 11/25/2003

### **REMARKS**

Claims 1-9, and 14-17 and 20-77 are currently pending in this application. Claims 1-2, 5, 20-40, 43 and 45-46 have been amended. Claims 1 and 20 have been amended to change the term iron particles to polarizable particles; support for these amendments may be found in various portions of the specification, specifically in paragraph [0015]. Applicants submit that these claims do not add new matter. Claims 47-77 have been added. Claims 10-13 and 18-19 have been cancelled. Reconsideration of the application in view of the following comments is respectfully requested.

#### German and French References

The Examiner has objected to the German and French language patents in the Information Disclosure Statement submitted on May 24, 2004. English counterparts of or English abstracts for these patents are included in the enclosed Information Disclosure Statement. Applicants respectfully request review of these references.

#### Objections to the Drawings

The Examiner has objected to Figures 1 and 2 as the reference characters disclosed in these Figures do not appear in the specification, rather they are described by incorporation by reference to U.S. Patent Publication No. 2001/0029400A1. Applicants have amended the specification to include the relevant portions of U.S. Patent Publication No. 2001/0029400A1 which describe Figures 1 and 2 (referred to as Figures 4 and 5 in U.S. Patent Publication No. 2001/0029400A1). The amendatory material consists of the same material incorporated by reference from U.S. Patent Publication No. 2001/0029400A1 and is therefore not new matter. Applicants submit that these amendments are fully responsive to the Examiner's objections.

#### Antecedent Basis Rejections of Claims 8, 9, 12, 28, 29, and 32

The Examiner states that the specification does not provide proper antecedent basis for the combinations of carrier fluids as claimed in Claims 8 and 28. Applicants respectfully point out that paragraph [0028] of the specification discloses the carrier fluids of Claims 8 and 28 and further states that "In another embodiment, the carrier fluid is a mixture of one or more carrier fluids."

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Applicants respectfully submit that this paragraph provides antecedent basis for the combination of carrier fluids as claimed in Claims 8 and 28.

The Examiner states that the specification does not provide proper antecedent basis for the carrier fluid being a mixture of PFPEs as claimed in Claims 9 and 29. Applicants respectfully submit that various PFPEs are disclosed as carrier fluids in paragraphs [0028-0035]. This disclosure combined with the statement above from paragraph [0028] provide antecedent basis for the mixture of PFPEs in Claims 9 and 29.

The Examiner states that the specification does not provide proper antecedent basis for the teaching of Claims 12 (rewritten as New Claim 56) and 32 that the combinations of the listed functional groups can be used. In response to this objection applicants have amended paragraph [0036]. Applicants submit that this amendment does not consist of new matter as originally filed Claim 12 provides support for this amendment. Applicants have also amended paragraph [0036] to correct a typographical error wherein dihydroxyl was spelled incorrectly. Applicants submit this error was purely typographical and does not constitute new matter.

Applicants submit that these remarks and amendments are fully responsive to the Examiner's objections to the specification.

#### Informality Objection to Claims 12 and 32

Claims 12 (now New Claim 56) and 32 have been amended as requested by the Examiner. Applicants submit these amendments are fully responsive to the Examiner's objections.

#### 35 U.S.C. §112, second paragraph, Rejection of Claims 20-46

The Examiner stated that the format of Claim 20 makes it unclear as to what is being claimed, a magnetorheological fluid or a prosthetic knee comprising the magnetorheological fluid. Applicants respectfully submit that Claim 20, and those depending therefrom, are directed to a prosthetic knee system comprising a magnetorheological fluid used with a prosthetic knee. Applicants have amended Claims 20-38 to clarify this matter. If the Examiner deems it appropriate Applicants respectfully invite the Examiner to issue a restriction requirement and withdraw these claims. Claims 39-40, 43 and 45-46 have been amended so that Claims 39-46 now depend from

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Claim 1. Applicants respectfully submit that these actions are fully responsive to the Examiner's objections.

35 U.S.C. §103(a) Rejection Over WO 02/10281

The examiner has rejected Claims 1-8, 11-12, 20-28, 31-32 and 39 as being obvious over WO 02/10281. For convenience applicants will refer to U.S. Patent No. 6,780,343 (the "'343" patent) as it is the English version of WO 02/10281. Applicants respectfully submit that the '343 patent does not render amended independent claim 1, or any claim depending therefrom, obvious. As the Examiner notes "there is no teaching or suggestion in the cited art of record of a magnetorheological fluid comprising a mixture of parafluoropropene and an oxygen polymerized amide derivative." Accordingly, Claim 1 is patentable over the '343 patent. In addition, the claims depending from Claim 1 include additional patentable distinctions and are patentable over the '343 patent for at least the same reasons as Claim 1.

Applicants submit that newly added Claims 47-61 are patentable over the '343 patent. The '343 patent states that "the stabilized dispersion magnetorheological fluid of the invention comprises a magnetic particle, a dispersive medium and a dispersing agent." Col. 2, lines 42-44. The patent discloses that the dispersive agent of the invention is a polyether of a specific formula. The patent further states that a supplemental dispersing agent, such as a perfluoroether carboxylic acid salt, may be used in addition to the dispersive agent of the invention. Accordingly, the '343 patents teaches that the perfluoroether carboxylic acid salt is not the claimed polyether of the invention. Moreover, the '343 patent teaches one of skill in the art that the perfluoroether carboxylic acid salt must be used in combination with the polyether dispersing agent of the '343 patent invention. This does not teach or suggest to one of skill in the art the magnetorheological fluid of Claim 47. Accordingly, Claim 47 is patentable over the '343 patent. In addition, the claims depending from Claim 47 include additional patentable distinctions and are patentable over the '343 patent for at least the same reasons as Claim 47.

Applicants also submit that newly added Claims 62-75 are patentable over the '343 patent. As the Examiner admits "there is no teaching or suggestion in the cited art of record of a magnetorheological fluid comprising a mixture of ... poly(hexafluoropropylene epoxide) with a carboxylic acid located on the terminal fluoromethylene group." Accordingly, Claim 62 is

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patentable over the '343 patent. In addition, the claims depending from Claim 62 include additional patentable distinctions and are patentable over the '343 patent for at least the same reasons as Claim 61.

35 U.S.C. §103(a) Rejection Over WO 02/10281 in view of U.S. Patent No. 5,382,373

The Examiner has rejected Claims 9, 14-17, 29, 34-36 and 40-46 as being obvious over WO 02/10281 (referred to herein as the '343 patent) in view of U.S. Patent No. 5,382,373 (the "'373" patent). The Examiner states that the '343 patent does not teach that a carrier can be a perfluorinated polyether or the amount of perfluoroether carboxylic acid salt dispersant. As discussed above applicants submit that the '343 patent does not render independent Claim 1, or any claim depending therefrom (e.g. claims 9, 14-17, 29, 34-36 and 40-46), obvious.

The Examiner states that as the '373 patent teaches conventional carrier fluids for magnetorheological fluids that include perfluorinated polyethers as well as the ones taught in the '343 patent, this would suggest to one of skill in the art that perfluorinated polyethers would be functionally equivalent to the fluids disclosed in the '343 patent and therefore suggest the claimed fluid. The Examiner also uses the claimed amount of dispersant in the '373 patent in combination with the '343 patent disclosure to suggest the amount of dispersive agent to be added. As discussed above Applicants submit that Claims 9, 14-17, 29, 34-36 and 40-46 are patentable over the '343 patent for at least the reason that they depend from Claim 1 which is patentable over the '343 patent. In addition, there is no motivation or suggestion to combine the '343 patent and the '373 patent as the Examiner has done. While both patents are directed towards magnetorheological fluids, the '373 patent focuses on the use of a specific type of particle – an iron alloy – as the key to their invention. See, e.g., col. 3, lines 25-45. One of skill in the art would not think to substitute the carrier fluid or dispersant amounts of the '373 patent in the '343 patent. Accordingly, Applicants submit that Claims 9, 14-17, 29, 34-36 and 40-46 are patentable over the '343 patent in view of the '373 patent.

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Conclusion

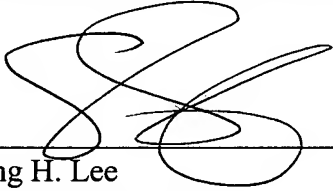
In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If, however, any questions remain, Examiner is cordially invited to contact the undersigned so that any such matters may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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